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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,773	05/01/2001	Kazuo Matsuzaki	M1971-92	4627
7278	7590	03/19/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			GHYKA, ALEXANDER G	
			ART UNIT	PAPER NUMBER
			2812	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,773

Applicant(s)

MATSUZAKI ET AL.

Examiner

Alexander G. Ghyska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 12-14 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

ALEXANDER GHYKA
PRIMARY EXAMINER

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claims 8-11 and 15-17 have been elected without traverse. Claims 1-7, 12-14 and 18-31 are withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 claims a third and fourth magnetic thin film, but does not mention a first or second magnetic thin film. As such, the claim is confusing and makes it difficult to ascertain the metes and bounds of the claim language. For example, are first and/or second magnetic thin films required? Therefore, the Claim is properly rejected under 35 USC 112 second paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lew et al (US 3,359,521).

The present claims generally require a manufacturing method for a magnetic thin film comprising a process for dispersing magnetic fine particles in a medium; a process for coating said medium on top of an insulating film; and a process for heat treating and solidifying the medium.

Lew et al disclose a method for forming a bistable memory device such as magnetic thin films. See Column 1, lines 40-45. Lew et al disclose the formation of an insulating layer which comprises discrete magnetic particles such as ferric oxide and a synthetic resin. See column 2, lines 60-66 and column 3, lines 60-70. Lew et al discloses the formation of a dispersion comprising the discrete metal particles, resin and a solvent, which is then coated and dried as required in present Claims 8 and 10. See column 3, line 70 to column 4, line 40. Moreover, Lew et al disclose the use of a resin

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as required in present Claim 9. See column 3, line 75. Furthermore, Lew et al disclose the use of toluene as required in Claim 11. See column 4, lines 1-5.

Therefore, Lew et al disclose all of the presently claimed limitations of the present Claims except coating the dispersion on an insulating layer.

It would have been obvious for one of ordinary skill in the art to coat the dispersion on an insulating layer as the use of numerous insulating layers would have been *prima facie obvious* to one of ordinary skill in the art for the known benefit of providing better insulation. The Lew reference discloses the use of various insulators. See column 8, lines 60 to column 9, line 10. In general, the transposition of process steps, or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner and result was held not to patentably distinguish the processes. *Ex Parte Rubin* 128 USPQ 159 (PTO Board of Appeals 1959). In the present case the duplication of forming the insulation layer for its benefit in providing better insulation would be *prima facie obvious*.

Allowable Subject Matter

Claims 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The cited prior art does not disclose or suggest filling a second resin in spaces in a spiral thin film conductor and forming a second magnetic thin film on top of the thin film conductor and the second resin, as required by the afore mentioned claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander G. Ghyka whose telephone number is (571) 272-1669. The examiner can normally be reached on Monday through Thursday during general business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John F Niebling can be reached on (571) 272-1679. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AGG
March 11, 2004

ALEXANDER GHYKA
PRIMARY EXAMINER

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